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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,895	07/30/2001	Loren R. Schuh	P 0555.10025	2427

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EXAMINER

BRAY, WAYMOND D

ART UNIT	PAPER NUMBER
3725	13

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/918,895

Applicant(s)
Schuh, et al

Examiner
W. Donald Bray

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3725



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 14, 16, 17, and 25-39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 14, 16, 25-30, 32, and 35-37 is/are rejected.
- 7) ☒ Claim(s) 17, 31, 33, 34, 38, and 39 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9 6) ☐ Other:

DETAILED ACTION

1. Because of the nature of the action, which follows herein below, prosecution of the merits is hereby reopened.

2. Applicant is advised that the Notice of Allowance mailed is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "projection (see: claim 13, line 10) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Treatment of Claims

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 26-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim s 26 and 28 are recites the limitation "outer clamping member" in lines 12, 14, and 15, respectively. There is insufficient antecedent basis for this limitation in the claim.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

8. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 13 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schmatjen (of record).

11. With regard to the embodiment as shown in figure 8, Schmatjen shows: A knife 140 for a wood chipping apparatus comprising opposed front and back sides co-terminating in two cutting edges 144, 146 defining a plane wherein said front side below said plane in Fig. 8 and said back side is above plane in Fig.8, the knife having an elongate axis (into the page in Fg.8), wherein said front side includes at least two points of maximum distance from said plane (on deflector ridges 148,150) and a surface 154

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there between to define a recess between said two points, and wherein said back side includes (option (b)) a surface 156 of maximum distance from said plane and at least two points of lesser distance from said plane that bound said surface to define a projection between said two points of said back side, wherein said knife is bilaterally symmetric about a plane parallel to said elongate axis.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 14, 16 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaiser (of record) in view of Schmatjen.

14. Zaiser shows an analogous knife 21 having a back side (to the right in Fig. 10) including at least two points of maximum distance from the plane defined by the cutting edges and a surface there between of lesser distance from said plane to define a semi-cylindrical recess (a groove having a semi-circular cross section in a plane perpendicular to the elongate axis) between said two points of said back side (to accommodate longitudinal rib 37). Zaiser fails to show deflector ridges. However, Schmatjen teaches an analogous knife having deflector ridges as set forth above (remaining limitations of claim 13). It would have been obvious to add the deflector portions 40, 42 or 148, 159 of Schmatjen to the Zaiser knife since Schmatjen teaches

that such would produce desired physical characteristics in chips cut by the knife. See col. 1, last paragraph.

15. Claims 25 is rejected under 35 U.S.C. 102(e) as being anticipated by Zaiser.

16. Zaiser shows: A clamp (Figs.4-6) for clamping a knife 21 having a back side for use in a wood chipping apparatus, comprising an inner surface 45 for disposition proximate to the back side of the knife including a projection 51 extending there from, said projection having at least two sides (side 50 and opposite side) that are substantially perpendicular to said inner surface 45, each connecting to a tip portion (end face) of the projection.

Note that the claim does not require that the projection engage the backside of the knife, but merely that the projection extend from the inner surface.

17. Claims 25, is alternatively rejected under 35 U.S.C. 102(b) as being anticipated by the newly cited patent to Humbert (3,989,077) which shows: A clamp (Fig.1) for clamping a knife 6 having a back side for use in a wood chipping apparatus, comprising an inner surface (adjacent surface of holder 3) for disposition proximate to the back side of the knife (Fig.1) including a projection (projection portions of stud 9) extending there from, said projection having at least two sides (see Fig. 1 cross-section) that are substantially perpendicular to said inner surface, each connecting to a tip portion (end face) of the projection.

18. Claims 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zaiser in view of Schmatjen, and further in view of Swartwood (of record).

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19. As set forth above, Zaiser in view of Schmatjen clearly teaches the wood chipping apparatus substantially as claimed, but fails to teach complementary interlocking features on the inner clamping member and front side of the knife. Rather, Schmatjen's clamp does not fully interlock with the front side of the knife since a space 86 is left between the knife and clamp, such that the knife could clip in the claimed direction. However, Swartwood et al. shows an analogous clamp for a knife 12 having deflector portions, wherein the complementary interlocking features on the inner clamping member 16 and front side of the knife 20 would prevent slipping in the claimed direction. It would have been obvious to the artisan to further modify Zaiser by providing a fully complementary interlocking feature on the inner clamping member since Swartwood suggests that such would more firmly hold the knife. See the background and summary of the invention.

20. Claims 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swartwood in view of Schmatjen, as applied herein above, and further in view of the newly cited patent to Jorgensen.

21. Swartwood et al. clearly teaches the clamp substantially as claimed (Figs.2-3) but fails to show that the outer clamping member is adapted for interlocking engagement with the back side of the knife. Rather, only the inner clamping member is so adapted. However, Jorgenson shows an analogous clamp (Fig.12) wherein both the inner and outer clamping member are adapted for interlocking engagement with respective sides of the knife. It would have been obvious to the artisan to modify Swartwood et al. by adapting both the inner and outer clamping members for

interlocking engagement with respective sides of the knife as in Jorgensen Fig. 12, since Swartwood et al. teaches to shape each of the clamping portions to fit the knife. See col.2, lines 48-57.

22. Applicant should note carefully that it would appear that the patent to Zaiser would anticipate a reasonable reading of claim 28. In this regard note that claims 26 and 28 do not require two sets of interlocking features as previously argued by applicant (See: page 7 of the amendment dated April 15, 2002) The rejection has not been imposed because of the issue of indefiniteness ascribed to the claim 28.

The patent to Buchacher, et al is cited as being directly applicable to claim 25, but is not being applied to avoid duplicate rejections.

23. Claims 17, 31, 33, 34, 38 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No claim is allowed.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to W. Donald Bray whose telephone number is (703) 308-1871. The examiner can normally be reached on Monday through Friday from 8:30 am to 3:00pm. Any inquires concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Ostrager can be reached on (703) 308-3136. The fax phone number for this Group is (703) 305-3579.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

Bray/DI

April 17, 2003

W. D. Bray
W. DONALD BRAY
PRIMARY EXAMINER